

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

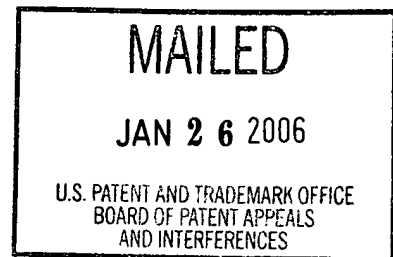
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN G. HENRY, GERALD L. MEYER, and MARTHA A. CHAVEZ

Appeal No. 2005-2528
Application No. 09/576,093

ON BRIEF



Before THOMAS, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 5-10, 12-24, and 30, which are all the claims remaining in the application.

We reverse.

BACKGROUND

The invention relates to an information caching system and method in which destination email addresses and facsimile numbers may be automatically stored for each user of a sending device. Representative claim 1 is reproduced below.

1. A method for processing sending information in a sending device, comprising:

receiving an entry input by a user at the sending device, the entry comprising sending information that identifies a destination to which information is to be sent by the sending device;

responsive to the entry, cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the contacts database, wherein the contacts database is stored within memory of the sending device; and

automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

The examiner relies on the following references:

Nielsen	US 6,405,243 B1	Jun. 11, 2002 (filed Apr. 5, 1996)
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Reilly	US 6,427,164 B1	Jul. 30, 2002 (filed Jun. 23, 1999)
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Claims 1, 5-10, 12-24, and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nielsen and Reilly.

We refer to the Final Rejection (mailed Mar. 31, 2004) and the Examiner's Answer (mailed Jan. 4, 2005) for a statement of the examiner's position and to the Brief

(filed Oct. 1, 2004) and the Reply Brief (filed Mar. 7, 2005) for appellants' position with respect to the claims which stand rejected.

OPINION

Nielsen describes an address-change server 103 (Fig. 1) on a network (e.g., Internet), whereby a mail recipient may transmit to the server an updated email address (i.e., the old and new address). Col. 3, ll. 48-65. Address-change server 103 includes database 135, which contains records comprising old and new email addresses. Col. 4, ll. 34-51. The reference further describes, in columns 5 through 7, several ways in which the destination address of an email that is sent to an "old" or outdated email address may be updated to the "new" destination address by use of the information contained in address-change server 103.

The examiner contended, in the final rejection, that Nielsen teaches receiving an entry input from a user (i.e., the old email address) and automatically caching the user-entered sending information if the information has not been previously saved, referring to step 507 of Figure 5 of the reference. (Final Rejection at 2-3.) Appellants point out that the antecedent in the claims for the information that is cached is that received from the user at the sending device. The new email address (step 507) is not the sending information entered at the sending device (i.e. not the old or original email address that was entered by the user). (Brief at 13.)

The examiner appears to recognize the weakness in the rejection that is set out in the Final Rejection. The examiner now deems the entry input received from the user to be the "new" email address, which is cached, as shown in step 507 of Figure 5.

(Answer at 4-5.) Appellants argue, however, that a dialog box asking the sender whether the sender's address book should be updated with the new email address of the recipient is not "responsive to the entry" of the information as claimed. (Reply Brief at 3-4.) We agree with appellants.

Under the examiner's latest interpretation of the reference, the content of the "new" email address entry is purported to be at lines 9 through 10 of column 7. (Answer at 4.) That section of the reference describes occurrences at the sending device after reception of the intended recipient's new email address from the address-change server. Nielsen col. 6, ll. 40-55. The sender's email program may display a dialog box which asks whether the message that could not be delivered to the recipient's old email address should be sent to the new email address. Col. 6, l. 56 - col. 7, l. 5.

In yet another embodiment, the dialog box also contains a checkbox (default: checked) asking the sender whether the sender's personal productivity applications (e.g., the sender's address book) should be updated with the new email address of the recipient. If the sender leaves this checkbox checked, and if the old email address was in the sender's address book, then the sender's email program also updates the sender's address book file. If the recipient's old email address was not in the sender's address book then it is added to the senders [sic; sender's] address book.

Col. 7, ll. 6-15. The sender's address book may then be updated with the recipient's new email address. Col. 7, ll. 16-25; Fig. 5.

Instant claim 1 recites, "receiving an entry input by a user at the sending device, the entry comprising sending information that identifies a destination to which information is to be sent by the sending device. . . ." In Nielsen, the user's entry does not comprise sending information that identifies a destination to which information is to be sent by the sending device, which sending information is later cached in the final step of the claim. In Nielsen, that sending information is generated by the sender's email program, or reproduced by the sender's email program from the new address provided by the address-change server. Independent claims 15 and 20 recite limitations similar to those of claim 1. Independent claim 9 requires that the user-entered information comprises "sending information, and determining the identity of the user from the entry. . . ." Nielsen does not describe the relevant user entry as comprising information from which the identity of the user may be determined.

We thus agree with appellants that Nielsen fails to disclose or suggest at least the above-noted features of the instant claims. Reilly does not remedy the basic deficiencies of the Nielsen reference. We therefore do not sustain the rejection of claims 1, 5-10, 12-24, and 30 under 35 U.S.C. § 103 as being unpatentable over Nielsen and Reilly.

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